

TRANSMITTAL FORM (to be used for all correspondence after initial filing) Total Number of Pages in This Submission	Application Number	10/643,383
	Filing Date	August 19, 2003
	First Named Inventor	Daniel J. White et al.
	Art Unit	1725
	Examiner Name	C. Shaw
	Attorney Docket Number	TN-2491A

ENCLOSURES (check all that apply)		
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Black & Decker Inc.		
Signature			
Printed Name	Adan Ayala, Esq.		
Date	February 14, 2006	Reg. No.	38,373

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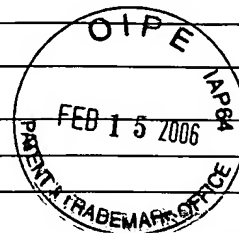
This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL
for FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 500**Complete if Known**

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**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify) : _____☒ Deposit Account Deposit Account Number: 02-2548 Deposit Account Name: Black & Decker (U.S.) Inc.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

Under 37 CFR 1.16 and 1.17

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	Fee(\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee(\$)	Fee Paid (\$)
_____ -20 or HP= _____	x _____	= _____	

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee(\$)	Fee Paid (\$)
_____ - 3 or HP= _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

Small Entity	
Fee (\$)	Fee (\$)
50	25
200	100
360	180
Multiple Dependent Claims	
Fee (\$)	Fee Paid (\$)
_____	_____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	/ 50 = _____	(round up to a whole number) x	= _____	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

Fees Paid (\$)

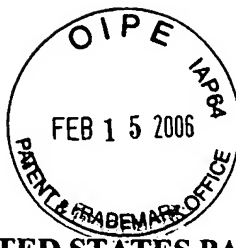
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SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	38,373	Telephone	410-716-2368
Name (Print/Type)	Adan Ayala, Esq.	Date	February 14, 2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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UTILITY PATENT

B&D No. TN2491A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: **Daniel J. WHITE et al.**

Serial No.: **10/643,383**

Examiner: **C. Shaw**

Filed: **August 19, 2003**

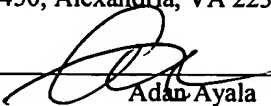
Group Art Unit: **1725**

For: **BATTERY PACK AND METHOD
FOR CONSTRUCTING SAME**

Assistant Commissioner for Patents
Washington, DC 20231

APPEAL BRIEF

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Adan Ayala

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UTILITY PATENT



B&D No. TN2491A

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UTILITY PATENT

B&D No. TN2491A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

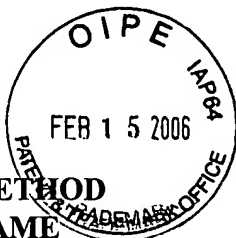
BOARD OF PATENT APPEALS AND INTERFERENCES

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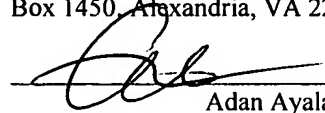
Examiner: **C. Shaw**

Group Art Unit: **1725**

Assistant Commissioner for Patents
Washington, DC 20231

APPEAL BRIEF

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Adan Ayala

Dear Sir:

I. INTRODUCTION

A final Office Action was mailed on December 1, 2005. In response to such Action, a Notice of Appeal was mailed on December 14, 2005, for the above-identified application. The present appeal brief is being timely filed as required under 37 CFR § 41.37.

II. REAL PARTY IN INTEREST

The real party in interest in the present case is Black & Decker Inc. An assignment transferring all rights to the present application and resulting patents was filed in the priority

UTILITY PATENT

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application, Ser. No. 60/303,496, filed July 6, 2001, now abandoned. The assignment was recorded on February 12, 2002 and can be found at Reel 012613, Frame 0693.

III. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences related to the present case are currently pending.

IV. STATUS OF CLAIMS

Claims 11-13 are currently pending and have been rejected in the present application.

Claims 1-10 have been canceled.

Claims 11-13 are presently appealed.

V. STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

Pursuant to 37 CFR § 41.37 and MPEP § 1206, Applicants/appellant hereby provide a concise explanation of the inventions defined in the claims involved in the present appeal.

This explanation refers to the specification by page and line number and to the drawings, as required by the CFR and the MPEP rules. However, the following explanation only refers to the embodiments disclosed in the specification and does not discuss alternative mechanisms that would be covered by the claims. Accordingly, the following explanation should not be used to limit the scope of the claims.

UTILITY PATENT

B&D No. TN2491A

Independent Claim 11 calls for a method for manufacturing a battery pack 10 comprising the steps of providing a housing 15 and two cells 11, at least one cell 11 having a weld area 11W. Spec., p. 4, lns. 1 & 21. A strap 13 is welded between the two cells 11. Spec., p. 4, lns. 2-3. The cells 11 are then disposed in the housing 15. Spec., p. 4, ln. 21. The strap 13 is welded by disposing a first electrode 16S on the strap 13 outside of the weld area 11W and a second electrode 16C on the at least one cell 11 outside of the weld area 11W, and providing a current between the first and second electrodes 16S, 16C. Spec., p. 4, lns. 5-7.

Claim 12 is dependent upon Claim 11 and thus includes the elements of Claim 11. In addition, Claim 12 further requires that the second electrode 16C contacts a side of the at least one cell 11. Spec., p. 5, lns. 4-5.

Claim 13 is dependent upon Claim 11 and thus includes the elements of Claim 11. In addition, Claim 13 further requires that the second electrode 16C contacts a periphery of the at least one cell 11.

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 11-13 are unpatentable under 35 USC § 103(a) over US Patent No. 5,298,712 (“Alexandres”) in view of the prior art acknowledged by the Applicants (“the APA”) and US Patent No. 4,322,597 (“Hooke”).

VIII. ARGUMENT

A. Claim 11 is Patentable under 35 USC § 103 over Alexandres in view of the APA and Hooke.

The Board should reverse the Examiner's improper final rejection of Claim 11 under 35 USC § 103 based on the combination of Alexandres/APA/Hooke. This is because, even if the three references were combined, such combination would not result in the claimed invention. Therefore, the Examiner's rejection was improper and should be reversed.

Admittedly, Alexandres teaches a method for manufacturing a battery pack including the steps of providing two cells, at least one cell having a weld area, welding a strap between the two cells via two electrodes, and providing a current between the two electrodes. However, Alexandres does not disclose disposing a first electrode on the strap outside of the weld area and a second electrode on the at least one cell outside of the weld area.

The Examiner noted that at least one of electrodes 54, 56, 58 is disposed outside of the weld area. However, all three electrodes are being placed on the button cap 42, which is typically the weld area. See, e.g., FIGS. 1C and 2C of the present application. Accordingly, Alexandres discloses placing three electrodes inside the weld area.

By contradistinction, Claim 11 requires "disposing a first electrode on the strap outside of the weld area." Accordingly, such claimed element is not disclosed in Alexandres.

Furthermore, Alexandres does not disclose placing any electrodes on the cell, as all three electrodes are placed on the strap. By contradistinction, Claim 11 requires "disposing ... a second electrode on the at least one cell." Such feature is not shown by Alexandres.

Even if Alexandres were combined with the APA and Hooke as suggested by the Examiner, the claimed method would not be practiced as the APA and Hooke show disposing at least one electrode within the weld area.

Accordingly, the Alexandres/APA/Hooke combination does not show all claimed elements of Claim 11. Therefore, such combination cannot render Claim 11 unpatentable.

B. Claim 12 is Patentable under 35 USC § 103 over Alexandres in view of the APA and Hooke.

The Board should reverse the Examiner's improper final rejection of Claim 12 under 35 USC § 103 based on the combination of Alexandres/APA/Hooke. This is because, even if the three references were combined, such combination would not result in the claimed invention. Therefore, the Examiner's rejection was improper and should be reversed.

As discussed above, the Alexandres/APA/Hooke does not disclose several elements of Claims 11 and 12. Furthermore, none of the references show the second electrode contacting a side of the cell. The Examiner alleges that, due to the breadth of the claimed language, Alexandres shows the second electrode contacting a side of the cell.

This is incorrect. As seen in FIG. 2 of Alexandres, all the electrodes contact the strap, not the cell. If the electrodes do not contact the cell, the second electrode cannot contact the side of the cell.

By contradistinction, Claim 12 requires that "the second electrode contact[] a side of the at least one cell." Since such feature is not shown by Alexandres, as alleged by the Examiner, neither it nor the Alexandres/APA/Hooke combination can render Claim 12 unpatentable.

C. Claim 13 is Patentable under 35 USC § 103 over Alexandres in view of the APA and Hooke.

The Board should reverse the Examiner's improper final rejection of Claim 13 under 35 USC § 103 based on the combination of Alexandres/APA/Hooke. This is because, even if the three references were combined, such combination would not result in the claimed invention. Therefore, the Examiner's rejection was improper and should be reversed.

As discussed above, the Alexandres/APA/Hooke does not disclose several elements of Claims 11 and 13. Furthermore, none of the references show the second electrode contacting a periphery of the cell. The Examiner alleges that, due to the breadth of the claimed language, Alexandres shows the second electrode contacting a periphery of the cell.

This is incorrect. As seen in FIG. 2 of Alexandres, all the electrodes contact the strap, not the cell. If the electrodes do not contact the cell, the second electrode cannot contact the periphery of the cell.

By contradistinction, Claim 13 requires that "the second electrode contact[] a periphery of the at least one cell." Since such feature is not shown by Alexandres, as alleged by the Examiner, neither it nor the Alexandres/APA/Hooke combination can render Claim 13 unpatentable.

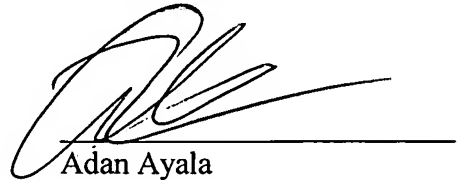
IX. APPENDICES

Applicants/Appellant have attached three appendices. In particular, Appendix A contains a copy of the claims involved in the appeal. In addition, Applicants/Appellant have attached an Evidence Appendix and a Related Proceeding Appendix.

X. CONCLUSION

Based on the foregoing, Applicants/Appellant urge the Board to rule that Claims 11-13 are patentable over the combination of Alexandres/APA/Hooke.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Adan Ayala', is written over a horizontal line.

Adan Ayala
PTO Reg. No. 38,373
Attorney for Applicants/Appellant

Appendices attached

APPENDIX A

CLAIMS INVOLVED IN APPEAL

Claim 11: A method for manufacturing a battery pack comprising the steps of:

providing a housing and two cells, at least one cell having a weld area;

welding a strap between the two cells; and

disposing the cells in the housing,

wherein the strap is welded by disposing a first electrode on the strap outside of the weld area and a second electrode on the at least one cell outside of the weld area, and providing a current between the first and second electrodes.

Claim 12: The method of Claim 11, wherein the second electrode contacts a side of the at least one cell.

Claim 13: The method of Claim 11, wherein the second electrode contacts a periphery of the at least one cell.

EVIDENCE APPENDIX

No Evidence is being submitted under 37 CFR §§ 1.130-1.132 or previously entered by the Examiner.

RELATED PROCEEDINGS APPENDIX

There are no currently pending appeals, interferences, or judicial proceedings related to the present case. No Board decisions or court decisions have issued in the previous related cases.